

REMARKS

Applicant's remarks below are preceded by quotations of the related comments of the Examiner in small, boldface type.

Applicant thanks the examiner for her thorough review of the claims. It is believed that these remarks address all of the pending claims. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

**Claim Rejections -35 USC § 101**

**3. 35 U. S. C. 101 reads as follows:**

**Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

**Claims 24 and 26-34 are rejected under 35 U. S. C. 101 because the bodies of the rejected claims do not recite technology, i. e. computer implementation or any other technology in a non-trivial manner. In re Torna, 197 USPQ 852 (CCPA 1978). Ex parte Bowman 61 USPQ2D 1669.**

...

Applicant has amended independent claim 24 to recite a method executed on a computing device. Claim 24 is further amended to recite "storing on a storage device in communication with said computer device the grade in a field corresponding to the graded aesthetic characteristics within the product profile." Applicant has amended independent claim 26 to recite a "computer-implemented method" that "occurs over a networked computer system." Accordingly, claims 24 and 26 recite actions that implement computer technology and thus

overcome the rejection. For at least the same reasons, dependent claims 25 and 27-34 also overcome the rejection.

**Claim Rejections -35 USC § 102**

...

**5. Claims 10, 13, and 15 are rejected under 35 U. S. C. 102(e) as being anticipated by Sammon, Jr.; et al. (U. S. PAT. 6012051A).**

**Re claim 10:** Sammon, Jr. et al. disclose a method executed on a computing device for producing an aesthetic profile tag for a user comprises: viewing an image that visually expresses one or more attribute scales; and entering, on a user input device associated with the computing device, preferences for the attribute scales (Abstract, col. 3, lines 50-60, col. 4, lines 55-67, col. 8, lines 15-col. 9, lines 1-40).

...

**8. Claims 11 and 14 are rejected under 35 U. S. C. 103(a) as being unpatentable over Sammon, Jr. et al. and Yourick (U. S. PAT. 4775935A).**

**Re claims 11 and 14:** Sammon, Jr. et al. do not explicitly disclose(s) wherein the aesthetic scales include at least one of form, material, decoration, overall appearance, and novelty. And compile an aesthetic profile tag for the user based on the received responses for the scales. However, in col. 1, lines 15-65, i. e. "group of items" is a set, and "certain types of persons" is the profile gleaned from user responses, and col. 2, lines 60-67, col. 4, lines 45-50, col. 10, lines 1-40 and Tables 9 and 10, thereof Yourick disclose attributes that identify the consumer 's interest such as whether the item has a certain specific characteristic. Thus, it would have been within the level of ordinary skill in the art to modify the method of Sammon, Jr. et al. by adopting the teachings of Yourick. The motivation to combine these references is that the Yourick reference talks about the characteristics of the products that can easily be classified as aesthetic such as clean, trendy, etc. and these characteristics are at least one of the form, material, decoration, overall appearance, and novelty.

...

**Re claim 12:** Sammon, Jr. et al. disclose each scale is further divided into three levels (col. 6, lines 25-30, i. e. a hierarchy has different levels).

Applicant disagrees. Amended claim 10 requires, among other things, viewing a set of test images that a grade associated with each aesthetic characteristic in a set of predetermined aesthetic characteristics. As explained in more detail below, Sammon does not discloses either

sending a user a set of images or sending the user a set of images in which aesthetic characteristics of the images has been graded.

In contrast to claim 10, Sammon does not disclose viewing a set of images. Sammon only teaches presenting textual descriptions of various attributes for a user to grade on a graphical slider bar. (See, e.g., FIGS. 4-14 of Sammon) Textual descriptions of attributes (as disclosed in Sammon) and the presentation of images can be significantly different when determining aesthetic preferences of people. Often a person will have a vague idea of what aesthetic attribute or combination of aesthetic attributes of a product appeals to them, but are unable to express their preferences in words. However, when the person sees a product embodying a particular combination of aesthetic attributes, the person immediately knows that they like that product. Thus, by viewing a set of images as required by claim 10, a more reliable profile for a user's aesthetic preferences may be established as compared to a system like Sammon in which textual descriptions of attributes are graded.

Sammon also clearly does not teach sending the user a set of images in which aesthetic characteristics of the images have been graded as required by claim 10.

Moreover, claim 10 requires the production of a profile of a user's preferences for aesthetic characteristics, whereas Sammon never produces a user profile. Rather, the Sammon system narrows pool of products based on a series of textual questions presented to the user. At the end of the process, Sammon produces a list of products that match the user's preferences, but it does not produce a profile of the user.

For at least these reasons, Applicant respectfully submits that claim 10, as well as dependent claims 11-12, are patentable over Sammon.

Claims 10-12 are also distinguished over the combination of Sammon and Nahan. In particular, Nahan, like Sammon, also does not teach or suggest sending the user a set of images in which aesthetic characteristics of the images have been graded as required by claim 10. Moreover, neither Nahan nor Sammon disclose viewing images selected from a plurality of images to visually express an aesthetic characteristic that includes at least one of form, material, decoration, overall appearance, or novelty as required by claim 11. Nahan describes a

computerized system for helping art dealers sell artwork. When a customer visits a dealer showroom equipped with the Nahan system, the “system guides the salesperson to display, on [a] larger monitor, images of artwork from the dealer’s own inventory and inventories of member dealers around the world, categorized by different criteria.” (Nahan 3: 43-49). As the customer peruses the displayed artwork, the customer is able to “examine details such as texture, condition, and color in images magnified on the System’s high resolution monitors.” (Nahan 3: 51-53). If the customer sees a piece that he or she likes, the salesperson can flag the selected art “to build a portfolio of possibilities” for the customer. (Nahan 3: 50-51). Nowhere does Nahan suggest presenting images to the user that have grades associated with each aesthetic attribute in a set of predetermined aesthetic attributes. Rather, the Nahan system simply presents the user with a series of images that the art dealer has in inventory or that the user has previously indicated an interest. Because neither Sammon nor Nahan alone or in combination teaches these presenting images in which aesthetic attributes have been graded to establish an profile for a user’s aesthetic preferenecs, claims 10-12 are patentable.

Moreover, there is no suggestion to combine the teaching of Sammon and Nahan because they are directed at two different systems. The Sammon system is directed at system for narrowing a pool of products (e.g., cars) based on a user’s response to questions about the user’s preferences for that type of product, whereas the Nahan system does not perform any product recommendation. Rather the Nahan system is simply a system that helps an art dealer efficiently present an inventory of artwork to potential customers for sale. Because Sammon and Nahan are directed at two significantly different systems, a person of ordinary skill in the art would have no motivation to apply aspects of one system to the other even if the combination of Sammon and Nahan were to teach each limitation of claims 10-12.

**Re claim 13: Sammon, Jr. et al. disclose a computer program product for selecting products, said computer program product residing on a computer readable medium comprises instructions for causing a computer to: receive from a user responses for preferences for aesthetic characteristics embodied in one or more images, wherein the computer program product produces a graphical user interface that contains questions that elicit information from the user regarding the user 's preferences for aesthetic characteristics related to at least one of form, texture,**

**material, color, pattern, extent of decoration, and overall product appearance (Abstract, Fig. 2, item 101 and 102, col. 5, lines 1-15 and lines 45-55).**

Applicant disagrees. Amended claim 13 requires, among other things, transmission over a networked computer system “a set of images selected from a plurality of test images, wherein each test image has a grade associated with each aesthetic characteristic in a set of predetermined aesthetic characteristics.” As explained above, Sammon does not teach either (i) presenting a user with a set of images or (ii) presenting the user a set of images in which aesthetic characteristics embodied in the images has been graded. Moreover, neither Nahan nor the other cited art disclose presenting a user with a set of images in which aesthetic characteristics embodied in the images have been graded. Accordingly, Applicant submits that amended claim 13, along with dependent claim 14, is patentable over the cited art.

**Re claim 15: Sammon, Jr. et al. disclose a system for selecting products, said system comprising: a computer; a computer program product residing on a computer readable medium comprises instructions for causing a computer to: receive from a user responses for preferences for aesthetic characteristics embodied in images that correspond to aesthetic features of products, wherein the computer program product produces a graphical user interface that contains questions that illicit the information from the user (Abstract, Col. 3, lines 25-35, col. 4, lines 60-col. 5, line 35, col. 11, lines 60-67, Fig. 1, claim 22, 31, 32).**

Applicant disagrees. Amended claim 15 requires, among other things, “a plurality of test images, wherein each test image has a grade associated with each aesthetic characteristic in a set of predetermined aesthetic characteristics.” As explained above, Sammon does not teach or suggest presenting a user with images or presenting a user with images in which aesthetic characteristics in the image have been graded. Moreover, neither Nahan nor the other cited art disclose presenting a user with a set of images in which aesthetic characteristics embodied in the images have been graded. Accordingly, claim 15 is also patentable over the cited art.

**Claim Rejections -35 USC § 103**

....

**7. Claims 1, 2, 3, 4, 5, 6, 7, 8, 12, 16, 17, 19, 20, 24, 25 and 26 are rejected under 35 U. S. C. 103(a) as being unpatentable over Sammon, Jr. et al. and Nahan et al. (U. S. PAT. 6343273B1).**

Re claims 1 and 16: Sammon, Jr. et al. disclose a method for selecting products that occurs over a networked computer system comprises: sending a user a web page with one or more images (Abstract, claim 49) one or more questions that request the user 's preferences for one or more of the images presented (Abstract, i. e. prompt, col. 3, lines 20-25); and receiving from a user a set of responses from the questions to produce a profile of the user 's preferences for aesthetic features of products (Col. 3, lines 25-35).

Sammon, Jr. et al. do not explicitly disclose(s) wherein at least one of the images emphasizes one or more aesthetic characteristics. However, in col. 3, lines 50-60, col. 4, lines 55-67, col. 8, lines 15-col. 9, lines 1-40 thereof, Nahan et al. disclose images of artwork that emphasizes aesthetic characteristics. Thus, it would have been within the level of ordinary skill in the art to modify the method of Sammon, Jr. et al. by adopting the teachings of Nahan et al. The motivation to combine these references is artwork, especially paintings, are filled with inherent aesthetic characteristics including texture and style. Thus, the artwork is a visual representation of various aesthetic characteristics. Showing the images via the web would be obvious because this method enables individuals to view images of products even if the products are not located nearby. Although Sammon, Jr. et al. is directed at buying cars, aesthetic characteristics come into the car-buying decision in the same way that aesthetic characteristics come into the artwork buying decision. Thus, the use of aesthetic characteristics to define the buyer 's preferences are parallel in these references in the same way as the applicant 's invention illustrates.

....

Applicant disagrees. Amended claim 1 requires, among other things, presenting a user with a plurality of images that each have "a grade associated with each aesthetic characteristic in a set of predetermined aesthetic characteristics." Similarly, claim 16 requires "selecting a set of images from a plurality of test images to present to a user, wherein each of the plurality of test images has a grade associated with each aesthetic characteristic in a predetermined set of aesthetic characteristics."

As explained above, neither Sammon nor Nahan disclose presenting a user with images in which aesthetic characteristics of the images have been graded. Because neither Sammon nor Nahan discloses this limitation, claims 1 and 16, along with dependent claims 2-8 and 18-23, are patentable.

Additionally, because Sammon and Nahan are directed at two significantly different systems, a person of ordinary skill in the art would have no motivation to apply aspects of one system to the other.

For at least these reasons, Applicant respectfully submits that claims 1 and 16, along with dependent claims 2-8 and 18-22, are patentable over the cited art.

Moreover, claim 21-22 are further distinguished over the combination of Sammon, Nahan, and Yourick. The examiner admits that Sammon and Nahan in combination do not disclose all of the limitations of claims 21-22. Neither does Yourick. For example, Yourick does not disclose selecting images to a user that are selected by the system to emphasize a particular aesthetic characteristic or combination of aesthetic characteristics as required in claim 21. Rather, Yourick establishes a user profile for a single session simply based on items that a *user* selects for demonstration (see, Yourck col 10: 5-7). Thus, Yourick does not teach a system in which the system selects certain images to present to the user are required by claim 21.

Similarly, Yourick does not disclose determining whether a user has given consistent responses to an aesthetic characteristics or combination of aesthetic characteristics emphasized in a plurality of sets of images before recording an aesthetic profile tag of a user as required in claim 22. Rather Yourick establishes a user profile for a single session simply based on items that a *user* selects for demonstration and never determines whether a consistent response has been given or otherwise “tests” the user’s responses. (Yourck col 10: 5-7). Thus, claims 21-22 are further distinguished over Yourick.

**Re claim 24: Sammon, Jr. et al. disclose a method for determining product profile, the method comprising the steps of: viewing a product; grading one or more aesthetic characteristics of the product on a scale; and storing the grade in a field corresponding to the graded aesthetic characteristics within the product profile (Abstract, claims 27,28, i. e. determining weights on the product images effectively creates the product profile and claim 49).**

**Re claim 25: Sammon, Jr. et al. disclose the step of viewing a product comprises: viewing one or more electronic images of the product (claims 22 and 49).**

**Re claim 26: Sammon, Jr. et al. disclose grading a plurality of characteristics of the product on a plurality of scales (Fig. 4-14); and storing the grades in a plurality of fields in a product profile (col. 2, lines 20-40).**

Sammon, Jr. et al. do not explicitly disclose wherein each wherein each field in the product profile corresponds to an aesthetic characteristic or combination of aesthetic characteristics. However, in Abstract, col. 3, lines 50-60, col. 4, lines 55-67, col. 8, lines 15-col. 9, lines 1-40 thereof, Nahan et al. disclose stylistic characteristics based on genre and artwork styles unique to different artists. And the paintings or sculpture indicate the various characteristics with aesthetic descriptions. Thus, it would have been within the level of ordinary skill in the art to modify the method of Sammon, Jr. et al. by adopting the teachings of Nahan et al. The motivation to combine these references is that the Nahan et al. reference provides a complete listing of aesthetic characteristics used in the art world which when combined in various categories lead to a comprehensive description of the product including style and genre that are attributes of the product.

Applicant disagrees. Sammon discloses a “product domain” that “consists of a list of items in a product domain, such as cars available on the market, along with specific product information concerning attributes available with each item in the set.” (Sammon 5: 14-19). However, Sammon does not disclose how the attributes of each item in the product domain are determined, let alone “grading an aesthetic characteristic of [a] product on a scale to produce a grade” as required by claim 24. The Abstract and claims 27, 28 and 49 of Sammon cited by the examiner are not directed at creating a product profile, but rather are directed at using an established user profile to search for products listed in a product domain. The “prompt display” discussed in claim 27 refers to a graphical user interface in which a user is prompted to enter attributes using a graphical slide bar on which the user would like to search (see, e.g., FIGS. 4, 6, 10-14) and has nothing to do with viewing a product in order to grade aesthetic characteristics of the product on a scale. The “machine readable specification” discussed in claim 28 assigns weights to product attributes in the product domain, not based on grading an image of the product, but based on the attributes on which the user would like to search. Thus, neither the cited passages from Sammon nor the remainder of Sammon teach this limitation.

Nahan also does not teach “grading an aesthetic characteristic of [a] product on a scale to produce a grade”. Rather Nahan teaches a product profile database in which products are simply categorized according to a series of attributes (e.g., style, medium, material, etc.). (Nahan col 8-col 9). Nowhere does Nahan suggest that various aesthetic attributes of the artwork is graded on a scale.

For at least these reasons, claim 24, along with dependent claims 25-26, are patentable over the combination of Sammon and Nahan.

**11. Claims 27, 28, 29, 33 and 34 are rejected under 35 U. S. C. 103(a) as being unpatentable over Tuzhilin (U. S. PAT. 6236978B1) and Nahan et al.**

**Re claim 27: Tuzhilin disclose retrieving a first user 's profile, wherein the first user's profile comprises one or more tags which correspond to the first user 's preferences; retrieving a second, different user 's profile, wherein the second user 's profile comprises one or more tags which correspond to the second user's preferences; and combining the first and second users profile to create a composite user profile (Abstract, i. e. "static and dynamic profile are then combined to form the user profile" and the user profile here is clearly a composite profile, and Fig. 6b and 6c and col. 3, lines 15-25).**

Tuzhilin does not explicitly disclose one or more aesthetic characteristics of products. However, in Abstract, col. 3, lines 50-60, col. 4, lines 55-67, col. 8, lines 15-col. 9, lines 1-40 thereof, Nahan et al. disclose stylistic characteristics based on genre and artwork styles unique to different artists. And the paintings or sculpture indicate the various characteristics with aesthetic descriptions. Thus, it would have been within the level of ordinary skill in the art to modify the method of Tuzhilin by adopting the teachings of Nahan et al. The motivation to combine these references is that the Nahan et al. reference provides a complete listing of aesthetic characteristics used in the art world which when combined in various categories lead to a comprehensive description of the product including style and genre that are attributes of the product.

....

Applicant disagrees. Tuzhilin does not disclose combining "a first user's profile with a second user's profile to create a composite profile of the first and second user" as required by claim 27. Rather, Tuzhilin discloses the creation of a single user's profile by combining a "static profile" of the user with a "dynamic profile" of the same user. (See, e.g., Tuzhilin 4: 9-11). Thus the resulting user profile in Tuzhilin is a combined static and dynamic profile of a single user. Nowhere does Tuzhilin teach or suggest combining profiles of two different users to create a composite profile of the two users as required in claim 27.

Moreover, Applicant also disagrees that there is some suggestion to combine the teaching of Sammon, Nahan and Tuzhilin. The systems described in these three patents are directed as different systems. As explained above, the Sammon system is directed at narrowing a pool of

Applicant : David Hornstein  
Serial No. : 09/543,868  
Filed : April 5, 2000  
Page : 20 of 20

Attorney's Docket No.: 11642-005001

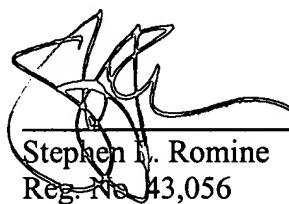
products (e.g., cars) based on a user's response to questions about the user's preferences for that type of product, whereas the Nahan system has no ability to recommend products to customers but is simply a system for efficiently presenting an inventory of artwork to potential customers for sale. The Tuzhilin system is a system for developing an intricate user profile for use in "one-to-one marketing applications" and is not especially designed to capture nebulous aesthetic preferences of customers. Because Sammon, Nahan, and Tuzhilin are directed at different systems, a person of ordinary skill in the art would not be motivated to combine their teachings.

For at least these reasons, Applicant respectfully submits that claim 27, along with dependent claims 28-34, are patentable.

Enclosed is a \$27 check for excess claim fees and a \$55 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 5/28/04



\_\_\_\_\_  
Stephen E. Romine  
Reg. No. 43,056

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110-2804  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906